

Practitioner's Docket No. U 015759-8

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application

of \_\_\_\_\_  
Inventor(s)

for \_\_\_\_\_  
Title of invention

OR

In re application of: Ekaterina Vladimirovna BARSOVA, et al

Serial No.: 10/533,781

Group No.: - -

Filed: October 19, 2005

Examiner: - -

For: FLUORESCENT PROTEINS FROM COPEPODA SPECIES AND METHODS FOR  
USING SAME

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT  
WITHIN THREE MONTHS OF FILING OR  
BEFORE MAILING OF FIRST OFFICE ACTION (37 C.F.R. 1.97(b))

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\*

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Date: November 23, 2005

- \* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

NOTE: 37 C.F.R. 1.98(b):

- (1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.
- (2) Each U.S. patent application published listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.
- (3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.
- (4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.
- (5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

WARNING: No extension of time can be had under 37 C.F.R. § 1.36 (a) or (b) for filing an IDS. 37 C.F.R. § 1.97(f).

NOTE: The "filing date of a national application" under 37 C.F.R. 1.97(b) has two possible meanings. Where the filing is a direct one to the United States Patent & Trademark office, the filing is defined in 37 C.F.R. 1.53(b) as "the date on which: (1) A specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41." 37 C.F.R. 1.97(b)(1). On the other hand, an international application that enters the national stage occurs when the applicant has filed the documents and fees required by 35 U.S.C. § 371(c) within the periods set forth in § 1.494 or § 1.495. 35 U.S.C. § 371(c) requires the filing of the following: (1) the national fee; (2) a copy of the international application, unless already sent by the International Bureau, and an English translation if filed in another language; (3) amendments under PCT Article 19, with a translation into English if made in another language; (4) an oath or declaration; and (5) a translation into English of any annexes to the international preliminary examination report, if such annexes were made in another language. 37 C.F.R. 1.97(b)(2).

## IDENTIFICATION OF TIME OF FILING THE ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

The information disclosure statement submitted herewith is being filed within three months of the filing date of the application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever event occurs last. 37 C.F.R. 1.97(b).

NOTE: "No certification or fee is due when the filing is made within the above time period. It is advisable to ensure that no Office action has been mailed if the disclosure statement is delayed until after three months from filing."

NOTE: "An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of a mailing if accompanied by a properly executed certificate of mailing under 37 C.F.R. 1.8, or Express Mail certificate under 37 C.F.R. 1.10. An office action is mailed on the date indicated in the Office action." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "The term 'national application' includes continuing applications (continuations, divisions, continuations-in-part) so three-months will be measured from the actual filing date of an application as opposed [sic] to the effective date of a continuing application." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**NOTE:** "An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirements (37 C.F.R. 1.142) or just a requirement for additional fees to have a claim considered (37 C.F.R. 1.16(d)). Thus, if an application was filed on Jan. 1 and the first Office action on the merits was not mailed until six months later on July 1, the examiner would be required to consider any proper information disclosure statement filed prior to July 1." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**WARNING:** "A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63). But see § 103(b) and (c), limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d) and in a request for continued examination (RCE) under § 1.114.

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SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

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P.O. Address

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c/o Ladas & Parry LLP  
26 West 61<sup>st</sup> Street  
New York, N.Y. 10023

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Ekaterina Vladimirovna **BARSOVA**, et al

Serial No.: 10/533,781

Group No. - -

Filed: October 19, 2005

Examiner: - -

For: **FLUORESCENT PROTEINS FROM COPEPODA SPECIES AND METHODS FOR USING SAME**

Attorney Docket No.: U 015759-8

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

We draw the attention of the Examiner to the attached references which are also listed on the attached Form PTO-1449.

**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***

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**37 C.F.R. 1.8(a)**

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Signature

**CLIFFORD J. MASS**

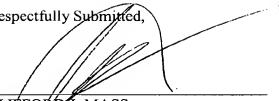
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Date: November 23, 2005

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"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

(Information Disclosure Statement Short Form—page 1 of 1) **6-1a**

Respectfully Submitted,



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CLIFFORD J. MASS  
C/O LADAS AND PARRY LLP  
26 WEST 61<sup>ST</sup> STREET  
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REG. NO. 30,086; (212) 708-1890

<b>FORM PTO-1449</b> <b>U. S DEPARTMENT OF COMMERCE</b> <b>PATENT AND TRADEMARK OFFICE</b>  <b>INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		<b>ATTY. DOCKET NO.</b>		<b>SERIAL NO.</b>		
		<b>U 015759-8</b>		<b>10/533,781</b>		
		<b>APPLICANT</b>				
		<b>Ekaterina Vladimirovna BARSOVA et al.</b>				
		<b>FILING DATE</b>		<b>GROUP</b>		
		<b>OCTOBER 19, 2005</b>				
<b>FOREIGN PATENT DOCUMENTS</b>						
		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AA	00/02997	01/2000	WO		
	AB	00/03246	01/2000	WO		
	AC	00/17643	03/2000	WO		
	AD	00/17624	03/2000	WO		
	AE	00/26408	05/2000	WO		
	AF	00/34318	06/2000	WO		
	AG	01/27150	04/2001	WO		
	AH	02/059309	08/2002	WO		
	AI	2003/062270	07/2003	WO		
<b>OTHER ART (Including Author, Title, Date, Pertinent Dates, Etc.)</b>						
	AJ	Lippincott-Schwartz, et al. "Development and Use of Fluorescent Protein Markers in Living Cells." <i>Science</i> (2003) Vol. 300, pp 87-91				
	AK	PubMed Abstract. Chalfie, M., et al. "Green Fluorescent Protein as a Marker for Gene Expression." <i>Science</i> (1994) Vol. 263 (5148), pp 802-805				
	AL	Heim, R., et al. "Wavelength Mutations and Postranslational Autoxidation of Green fluorescent Protein." <i>Proc. Natl. Acad. Sci. USA</i> (1994) No. 91, pp 12501-12504				
	AM	PubMed Abstract. Rizzuto, R., et al. "Chimeric Green Fluorescent Protein as a Tool for Visualizing Subcellular Organelles in Living Cells." <i>Curr. Biol.</i> (1995) Vol. 5 (6) pp 635-642				
	AN	PubMed Abstract. Kaether, C., et al. "Visualization of Protein Transport Along the Secretory Pathway Using Green Fluorescent Protein." <i>Febs. Lett.</i> (1995) Vol. 369 (2-3) pp 267-271				
	AO	PubMed Abstract. Haas, J., et al. "Codon Usage Limitation in the Expression of HIV-1 Envelope Glycoprotein." <i>Curr. Biol.</i> (1996) Vol. 6(3) pp 315-324				
	AP	Yang, T., et al. "Optimized Codon Usage and Chromophore Mutations Provide Enhanced Sensitivity with the Green Fluorescent Protein." <i>Nucl. Acids Res.</i> (1996) 24, pp 4592-4594				
	AQ	Matz, M., et al. "Fluorescent Proteins from Nonbioluminescent Anthozoa Species." <i>Nature Biotechnology</i> (1999) Vol. 17, pp 969-973				
	AR	Matz, M., et al. "Family of the Green Fluorescent Protein: Journey to the End of the Rainbow." <i>Bioessays</i> (2002) Vol. 24, No. 10, pp 953-959				
	AS	Xia, N., et al. "Bioluminescence of Aequorea Macroductyla, a Common Jellyfish Species in the East China Sea." <i>Marine Biotechnology</i> (2002) Vol. 4, pp 155-162				
	AT	Gurskaya, N., et al. "A Colourless Green Fluorescent Protein Homologue from the Non-Fluorescent Hydromedusa Aequorea Coeruleus and Its Fluorescent Mutants." <i>Biochem. J.</i> (2003) 373, pp 403-408				
<b>EXAMINER</b>				<b>DATE CONSIDERED</b>		
<b>EXAMINER:</b> Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.						

FORM PTO-1449		U. S DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO.	SERIAL NO.
				U 015759-8	10/533,781
INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Use several sheets if necessary)		APPLICANT			
		Ekaterina Vladimirovna BARSOVA et al.			
		FILING DATE	GROUP		
		OCTOBER 19, 2005			
U.S. PATENT DOCUMENTS					
EXAMINER INITIALS	REFERENCE DESIGNATION	DOCUMENT NUMBER	DATE	NAME	FILING DATE IF APPROPRIATE
	AA	6,066,476	05/2000	Tsien et al.	
	AB	6,020,192	02/2000	Muzyczka et al.	
	AC	5,985,577	11/1999	Bulinski	
	AD	5,976,796	11/1999	Szalay et al.	
	AE	5,968,750	10/1999	Zolotukhin et al.	
	AF	5,968,738	10/1999	Anderson et al.	
	AG	5,958,713	10/1997	Thastrup et al.	
	AH	5,919,445	07/1999	Chao	
	AI	5,874,304	02/1999	Zolotukhin et al.	
	AJ	5,843,746	12/1998	Tatsumi et al.	
	AK	5,700,673	12/1997	McElroy et al.	
	AL	5,674,713	10/1997	McElroy et al.	
	AM	5,618,722	04/1997	Zenno et al.	
	AN	5,418,155	05/1995	Cormier et al.	
	AO	5,330,906	07/1994	Kajiyama et al.	
	AP	5,229,285	07/1993	Kajiyama et al.	
	AQ	5,221,623	06/1993	Legocki et al.	
	AR	5,182,202	01/1993	Kajiyama et al.	
	AS	6,008,373	12/1999	Waggoner et al.	
	AT	5,998,146	12/1999	Latva et al.	
	AU	5,981,200	11/1999	Tsien et al.	
	AV	5,945,526	08/1999	Lee et al.	
	AW	5,945,283	08/1999	Kwok et al.	
	AX	5,911,952	06/1999	Tsuji	
	AY	5,869,255	02/1999	Mathies et al.	
	AZ	5,866,336	02/1999	Nazarenko et al.	
EXAMINER			DATE CONSIDERED		
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.					

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		<b>Ekaterina Vladimirovna BARSOVA et al.</b>				
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		<b>OCTOBER 19, 2005</b>				
<b>U.S. PATENT DOCUMENTS</b>						
EXAMINER INITIALS	REFERENCE DESIGNATION	DOCUMENT NUMBER	DATE	NAME	FILING DATE IF APPROPRIATE	
	AA	5,863,727	01/1999	Lee et al.		
	AB	5,728,528	03/1998	Mathies et al.		
	AC	5,707,804	01/1998	Mathies et al.		
	AD	5,688,648	11/1997	Mathies et al.		
	AE	5,439,797	08/1995	Tsien et al.		
	AF	5,989,835	11/1999	Dunlay et al.		
	AG	6,130,313	10/2000	Li et al.		
	AH	5,972,638	10/1998	Burlage et al.		
	AI	5,824,485	10/1998	Thompson et al.		
	AJ	5,650,135	07/1997	Contag et al.		
	AK	5,491,084	08/1998	Chalfie et al.		
	AL	5,795,737	08/1998	Seed et al.		
<b>FOREIGN PATENT DOCUMENTS</b>						
		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AM					
	AN					
	AO					
	AP					
<b>OTHER ART (Including Author, Title, Date, Pertinent Dates, Etc.)</b>						
	AQ					
	AR					
	AS					
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